

### **REMARKS**

The above listed claim amendments and the following remarks are believed to be fully responsive to the Office Action. By this Amendment, claims 1, 3, 5, 23, 26, 43, 44 and 51-53 have been amended and claims 54-58 have been canceled, such that claims 1-3, 5-7, 23-26, 43-49, 51-53 and 59-60 are pending in the Application.

#### **35 U.S.C § 112, 2<sup>nd</sup> paragraph**

Claims 1-3, 5-7, 23-26, 43, 51-53 and 55-56 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. The claims have been appropriately amended, thereby rendering the rejection moot. Favorable reconsideration is respectfully requested.

#### **Claim Rejections 35 U.S.C. § 102**

Claims 1-3, 5-7, 23-24, 43-47, 51-52 and 55-60 stand rejected under § 102(b) as being anticipated by Cross et al. (U.S. Pat. No. 5,935,159). Applicant respectfully traverses this rejection. In order to anticipate, the cited reference must disclose each and every claimed feature and element. Cross fails to do so.

In particular, claim 1 recites an implantable lead including, among other elements, a tubular lead body having an inner body surface and an insulated coil conductor that extends through the tubular lead body to form a generally annular hollow between the inner body surface and the insulated coil conductor. At least one filler is disposed within the generally annular hollow. The filler defines void spaces that enable the filler to compress or otherwise move with the lead body, as supported for example in Figures 2-4. These Figures clearly show void spaces that are formed by an undulating inner surface of the filler(s) 140.

One of ordinary skill in the art, having read and understood the specification and drawings, will understand that the Figures show the claimed void spaces. Moreover, these are cross-sectional drawings in which various cross-hatching markings are used to denote particular materials. The claimed voids are drawn without cross-hatching, just like the

internal lumen extending through the insulated coil conductor 130. Thus, standard drawing notation also indicates that there are void spaces defined by the filler(s) 140.

Cross does not describe a filler having the claimed void spaces that enable the filler to compress or otherwise move with the lead body. Rather, Cross describes a core member that includes elongate grooves designed to accommodate insulated conductors that can be snap-fit into the elongate grooves. While there may be small voids formed between the core 102 and the outer tube 100 after the conductors have been positioned (see Figure 3 of Cross, for example), one of ordinary skill in the art will appreciate that these small voids are not sufficient to permit the core 102 to move with the lead body, as is required in the instantly claimed invention.

For at least these reasons, independent claim 1 is not anticipated by Cross. Claims 2-3, 5-7, 23-24 and 43 include the elements of claim 1 and are patentable for at least the same reason. Claims 2-3, 5-7, 23-24 and 43 also include further distinguishing features.

As discussed above, Cross does not describe the claimed void spaces that enable the filler to compress or otherwise move with the lead body. Moreover, claim 44 recites that the filler is disposed between a lead lumen surface and the coiled conductor and extends only partially around the coiled conductor. Even if the core 102 is considered equivalent to the claimed filler (a point not conceded), Cross does not describe or disclose an embodiment in which the coiled conductor is not completely surrounded by the core 102. Cross describes embodiments (see Figure 11) in which a coiled conductor extends through the center of the core 102, and thus the core extends more than just partially around the coiled conductor. If a coiled conductor is placed in one of the elongate grooves, the core does not extend between a lead lumen surface and the coiled conductor.

For at least these reasons, independent claim 44 is not anticipated by Cross. Claims 45-49 include the elements of claim 44 and are patentable for at least the same reason. Claims 45-49 also include further distinguishing features.

As discussed above, Cross does not describe the claimed void spaces that enable the filler to compress or otherwise move with the lead body. Claim 51 further recites that the void spaces are disposed along a portion of the filler that is adjacent the insulated coil conductor. Cross fails to describe the claimed void spaces and moreover also fails to

describe the claimed location thereof.

For at least these reasons, independent claim 51 is not anticipated by Cross. Claims 52-53 and 59-60 include the elements of claim 51 and are patentable for at least the same reason. Claims 52-53 and 59-60 also include further distinguishing features. Reconsideration and withdrawal of the rejection is respectfully requested.

### **Claim Rejections 35 U.S.C. § 103**

Claim 21 stands rejected under § 103(a) as being unpatentable over Cross et al. (U.S. Pat. No. 5,935,159). The Examiners' reliance on "one of ordinary skill in the art" does not remedy the above-noted shortcomings of claim 1. Claim 1, from which claim 21 depends, is patentable over Cross. Claim 21 includes the elements of claim 1 and is patentable for at least the same reasons. Claim 21 also includes further distinguishing features. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim 25 stands rejected under § 103(a) as being unpatentable over Cross et al. (U.S. Pat. No. 5,935,159). The Examiners' reliance on "one of ordinary skill in the art" does not remedy the above-noted shortcomings of claim 1. Claim 1, from which claim 25 depends, is patentable over Cross. Claim 25 includes the elements of claim 1 and is patentable for at least the same reasons. Claim 25 also includes further distinguishing features. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 49-50 and 53-54 stand rejected under § 103(a) as being unpatentable over Cross et al. (U.S. Pat. No. 5,935,159). The Examiners' reliance on "one of ordinary skill in the art" does not remedy the above-noted shortcomings of claim 1. Claim 44, from which claims 49-50 depend, and claim 51, from which claims 53-54 depend, are patentable over Cross. Claims 49-50 and 53-54 include the elements of claims 44 and 51, respectively, and are patentable for at least the same reasons. Claims 49-50 and 53-54 also include further distinguishing features. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 26 and 48 stand rejected under § 103(a) as being unpatentable over Cross et al. (U.S. Pat. No. 5,935,159) in view of Dahl et al. (U.S. Pat. No. 5,366,496). Claim 1, from

which claim 26 depends, and claim 44, from which claim 48 depends, are patentable over Cross. Dahl does not remedy the noted shortcomings of Cross, and thus claims 1 and 44 are patentable over the asserted combination. Claims 26 and 48 include the elements of claims 1 and 44, respectively, and are patentable for at least the same reasons. Claims 26 and 48 also include further distinguishing features. Reconsideration and withdrawal of the rejection is respectfully requested.

### **Conclusion**

In sum, all of the claims pending for examination are believed to be in condition for allowance. In view of the foregoing amendments and remarks, withdrawal of the objections and rejections and notice to that effect are respectfully requested. If there are any remaining questions, the Examiner is invited to contact the undersigned at the number listed below in order to expedite prosecution of the application.

Respectfully submitted,

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